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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,232	02/05/2001	Lorraine Mignault	82223-202	1664

7590 08/08/2002

Ade & Company
1700 360 Main Street
Winnipeg, R3C 3Z3
CANADA

EXAMINER	
WILLIS, MICHAEL A	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/762,232	MIGNAULT, LORRAINE	
	Examiner	Art Unit	
	Michael A. Willis	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2002 and 24 June 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,17-22,24 and 25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,17-22,24 and 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☒ Interview Summary (PTO-413) Paper No(s). *13* .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's responses of 10 May 2002 and 24 June 2002 are entered. Claims 1, 8, 17, 18, and 20 are amended. Claim 25 is added. Claims 10, 11, and 23 are cancelled. Claims 1-9, 17-22, and 24-25 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claims 1, 2, and 25 are rejected under 35 USC 102(b) as being anticipated by Weed (Wise Woman, Herbal Healing Wise; 1989, pp. 192-205) for reasons as stated previously.

Applicant argues that the claims as amended are directed to extracts prepared by steeping oatstraw in boiling water and then preparing a lotion from the extract. Applicant argues that adding a compound to bath water does not teach preparing a lotion for topical application. In response, the recitation "a topical lotion for relieving pain, swelling or inflammation" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Similarly, a recitation of the

intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant argues that an aqueous extraction at boiling versus 35-45°C will yield differences in specific compounds, their concentration, and their stability. However, the claims are directed to "steeping oatstraw in water heated until hot and tiny bubbles have formed" instead of boiling water. Even if applicant's statement that the claims are directed at boiling water is accepted, the reference teaches the use of boiling water. "Boil water and pour over oatstraw in a large tub. When cooled sufficiently, bathe." (page 205, line 25).

Applicant argues that "filtered and magnetized water" is patentably distinct in that during such process, the hydrogen ions and dissolved minerals in the water become charged, causing a temporary separation of these minerals and molecular water clusters resulting in water with increased clarity and softness, and reduced surface tension. The examiner can find no support in scientific literature that "magnetized" water differs from "water" in any way. Therefore, such limitation is not given patentable weight. While the examiner concedes that filtering water can remove impurities from water, it is not clear that the water disclosed in the reference contains such impurities. In other words, even ordinary tap water is inherently processed in such a way as to meet the broad limitation of "filtered".

Claims 1-9, 17-22, and 24-25 are rejected under 35 USC 103(a) as being unpatentable over Weed (Wise Woman, Herbal Healing Wise; 1989, pp. 192-205) in view of Puchalski, Jr. et al (US Pat. 4,690,818) and Jakobson et al (US Pat. 5,397,497) for reasons as stated previously.

Applicant argues that the amendments and arguments with respect to the rejection under 35 USC 102(b) above serve to also overcome the rejection under 35 USC 103. See above for examiner's response to the arguments.

A phone interview was conducted on 18 July 2002 (see attached interview summary) to discuss conditions for allowance. It is the position of the examiner that arguments specifically directed at the combination of references would be considered favorably, and that incorporation of the limitations of claims 3 and 4 into the independent claims may serve to overcome all rejections over the prior art.

The following new ground of rejection is made:

Claim Rejections - 35 USC § 112

Claims 1-9, 17-22, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "water heated until hot and tiny bubble have formed" is vague. It is unclear if the water is actually boiling, or if a range of temperatures is included. The rejection can be overcome by amending the phrase to read "heated water".

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday(9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Travers (acting SPE) can be reached on (703) 308-4603. The fax phone numbers for the organization where this application or proceeding is assigned

are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Michael A. Willis
Examiner
Art Unit 1617

maw
August 5, 2002

MICHAEL G. HARTLEY
PRIMARY EXAMINER